

Notice of Allowability

Application No.

10/074,180

Examiner

Taylor Victor Oh

Applicant(s)

LANGE ET AL.

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 1/07/05.
2. ☒ The allowed claim(s) is/are 10-14 and 16, renumbered as claims 1-6.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date <u>3/24/05</u> . |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

The Amendment after the Final rejection filed on 1/7/05 will be entered.; the Final rejection has been withdrawn.

Examiner's Amendment and Reasons of Allowance

The Status of Claims

Claims 10-14 and 16 are pending.

Claims 10-14 and 16 have been allowed.

Claims 1-9 have been canceled.

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with an attorney of record, Mr. Van Eyn Diderich on 3/24/05 .

I. The application has been amended as follows:

In claim 10, lines 3-4, on page 3 (the amendment dated on 1/7/05), the phrase “ -- or with methyl, ethyl, butyl or amyl nitrite sulfuric acid-containing methanol --”after the phrase “ in aqueous sulfuric acid ” has been replaced with the phrase “ or sulfuric acid in combination with methanol , or with an alkyl nitrite selected from the group consisting of methyl, ethyl, butyl and amyl nitrite”.

- The following is an examiner's statement of reasons for allowance:
 - The rejection of Claim 15 under 35 U.S.C. 102(b) as being anticipated clearly by Novelli et al (WO 00/08023) has been withdrawn due to the cancellation made in the amendment;
 - The closest prior art to the current invention are Saumitra et al (J. Chem. Soc. PERKIN Trans, p. 1943-1944, 1993) and Kikukawa et al (J. Org. Chem. 1981, Vol. 46, No. 24, p. 4885-4888).

Saumitra et al discloses a method of preparing a halogenated cinnamate compound by reacting arenediazonium tetrafluoroborates with an olefin in the presence of 1-2 mol% of $\text{Pd}(\text{OAc})_2$ and a solution of NaNO_2 in water.

Kikukawa et al teaches a method for phenylation of olefins by aniline under palladium catalysis, during which a diazonium salt is formed in situ. Furthermore, different forms of palladium complexes, such as, palladium (II) acetate, tetrakis (triphenylphosphine)palladium can be applied to the method.

However, the instant invention differs from the prior art in that none of the prior art teach or suggest a method of preparing cinnamate compounds by using the at least two of the halogen substituents on the phenyl ring as the starting material reagent. In addition, unless all limitations

of the claims are met, there is no prior art rejection. See In re Zurko 59 USPQ 2d 1690 (Fed Cir. 1991) and In re Lee, 61 USPQ 1430 (Fed Cir. 1991).

Therefore, the claimed invention would not have been obvious to the skilled artisan in the art because there are no teachings in both prior art to be motivated to modify the combined processes of the Saumitra et al and the Kikukawa et al by using compounds with two or more halogen substituents.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning the communication after allowance such as sending all post-allowance correspondence should be directed to "Box Issue Fee" or faxed directly to PUBS at 703-305-8755. This will expedite the process of these papers.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

My final OK
3/24/05

Cecilia J. Tsang
Cecilia J. Tsang
Supervisory Patent Examiner
Technology Center 1600